

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RANDY W. SIMON, CHRISTINE E. PLATT,  
ALFRED E. LEE and GREGORY S. LEE

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Appeal No. 1995-5082  
Application No. 07/803,935

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HEARD: August 16, 2000

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Before KIMLIN, WALTZ and TIMM, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 23-29 and 31-34. Claim 23 is illustrative:

23. A superconductor Josephson junction comprising:

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(a) a lanthanum aluminate substrate; and

(b) at least one superconductor film on the lanthanum aluminate substrate.

In the rejection of the appealed claims, the examiner does not rely upon prior art.

The present application is related to two other applications presently before us on appeal, namely, U.S. Application No. 08/433,818 (Appeal No. 1997-2063) and U.S. Application No. 08/308,781 (Appeal No. 1997-0054). The present application and the two related applications are all, ultimately, continuations of parent Application No. 07/233,637, filed August 18, 1988, now U.S. Patent No. 5,523,282.

Appealed claims 23-27 and 31-34 stand rejected under 35 U.S.C. § 112, first paragraph. Claim 27 stands rejected under 35 U.S.C. § 101. In addition, claims 23-29 and 31-34 stand rejected under 35 U.S.C. § 101 as claiming the same invention as the claims in the parent application, U.S. Application No. 07/233,637 (U.S. Patent No. 5,523,282).

For the reasons set forth in our decision in the related application, U.S. Application No. 08/433,818 (Appeal No.

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1997-2063), which reasons we incorporate herein, we will not sustain the examiner's rejections under 35 U.S.C. § 112, first paragraph, nor the examiner's rejection of claim 27 under 35 U.S.C. § 101.

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Appellants do not contest the examiner's rejection of the appealed claims under 35 U.S.C. § 101, double patenting. Appellants state at page 28 of the principal brief that they "will file a terminal disclaimer at the appropriate time, in order to overcome the obviousness-type double patenting rejection." However, the examiner's rejection is under 35 U.S.C. § 101 and not under the judicially created doctrine of obviousness-type double patenting. Consequently, a terminal disclaimer cannot obviate such a rejection under 35 U.S.C. § 101. However, the examiner's statement at page 13 of the Answer that "the double patenting rejection is maintained until the terminal disclaimer is filed and approved" lends confusion as to the actual nature of the examiner's rejection. Accordingly, due to the uncertainty regarding the basis for the double patenting rejection, this application is remanded to the examiner for the purpose of resolving this issue.

The examiner's rejections under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 101 (claim 27) are reversed. The application is remanded to the examiner for the reasons stated above.

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This application, by virtue of its "special" status,  
requires immediate action. See the Manual of Patent Examining

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Procedure, § 708.01(D) (7th ed., July 1998). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case.

REVERSED AND REMANDED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
THOMAS A. WALTZ	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
CATHERINE TIMM	)	
Administrative Patent Judge	)	

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